



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,379	11/15/2001	John Joseph Mascavage III	020375-002710US	2669
20350 7590 04/30/2010 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER CHENCINSKI, SIEGFRIED E				
ART UNIT 3695		PAPER NUMBER		
MAIL DATE 04/30/2010		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE  
2  
3

---

4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6  
7

---

8 *Ex parte* JOHN JOSEPH MASCAVAGE, III, MARGARET MORGAN  
9 WEICHERT, and ROBERT EDWIN DRAVENSTOTT  
10

---

11 Appeal 2009-006562  
12 Application 09/991,379  
13 Technology Center 3600  
14  
15

---

16  
17 Decided: April 30, 2010  
18  
19

---

20  
21 *Before* MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R.  
22 MOHANTY, *Administrative Patent Judges*.  
23  
24 CRAWFORD, *Administrative Patent Judge*.  
25  
26

27  
DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented systems and methods for authorizing an online purchase between a customer and a vendor (Abstr.).

Claim 1 under appeal is further illustrative of the claimed invention as follows:

1. A method for authorizing an online purchase between a customer and a vendor site, the method comprising steps of:

at a funds transaction server, receiving transaction information from the vendor site, wherein the transaction information comprises a transaction amount;

opening a pop-up window for the customer;

from the funds transfer sever, interacting with the pop-up window to present a transaction amount in the pop-up window and receiving customer assent to the transaction amount;

receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and

notifying the vendor site of authorization.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Daniels	US 5,758,126	May 26, 1998
Stein	US 5,826,241	Oct. 20, 1998
Wilf	US 5,899,980	May 4, 1999
Kolling	US 5,920,847	Jul. 6, 1999 <sup>1</sup>

---

<sup>1</sup>While Kolling is not listed in the Evidence Relied Upon section on pages 2-3 of the Examiner's Answer, Kolling has been cited in rejecting claims 8 and

1	Matyas	US 6,102,287	Aug. 15, 2000
2	Paltenghe	US 2002/0004783 A1	Jan. 10, 2002

3 Applicants' Admitted Prior Art (hereinafter "AAPA").

4 The Examiner rejected claims 1-7, 9-15, and 17-20 under 35 U.S.C. §  
5 103(a) as being unpatentable over Wilf in view of Stein, Paltenghe, Daniels,  
6 Matyas, and AAPA.

7 The Examiner rejected claims 8 and 16 under 35 U.S.C. § 103(a) as  
8 being unpatentable over Wilf, Stein, Fung, AAPA, and Kolling.

9 We AFFIRM-IN-PART.

10

11 ISSUES

12 Did the Examiner err in asserting that a combination of Wilf, Stein,  
13 Paltenghe, Daniels, Matyas, and AAPA renders obvious the recitation of  
14 "from the funds transfer server," "interacting with the pop-up window to  
15 present a transaction amount in the pop-up window," and "receiving  
16 customer assent to the transaction amount," as recited in independent claims  
17 1, 10, and 17?

18 Did the Examiner err in combining Wilf, Stein, Paltenghe, Daniels,  
19 Matyas, and AAPA, because the Examiner failed to identify the level of skill  
20 in the relevant art?

21 Did the Examiner err in combining Wilf, Stein, Paltenghe, Daniels,  
22 Matyas, and AAPA, because the Examiner only set forth one motivation  
23 from Wilf for combining all of the references?

---

16 in every Office Action beginning with a non-final Office Action mailed March 6, 2003. Moreover, Appellants have not argued the merits of Kolling. Accordingly, the omission of Kolling from the Evidence Relied Upon section is considered inadvertent and substantively irrelevant to this appeal.

1 Did the Examiner err in asserting that a combination of Wilf, Daniels,  
2 Matyas, and AAPA renders obvious “wherein the pop-up window overlays  
3 an existing web browser window of a web site associated with the merchant  
4 system,” as recited in dependent claim 12?

5 Did the Examiner err in asserting that a combination of Wilf, Daniels,  
6 Matyas, and AAPA renders obvious “wherein the receiving transaction  
7 information step triggers the opening a pop-up window step,” as recited in  
8 dependent claim 13?

9  
10 FINDINGS OF FACT

11 *Specification*

12 Appellants invented systems and methods for authorizing an online  
13 purchase between a customer and a vendor (Abstr.).

14  
15 *Wilf*

16 Wilf discloses that a preferred way of payment is by credit card.  
17 However, because of security concerns there is great reluctance of the users  
18 to transmit credit card account information over the Internet (col. 1, ll. 24-  
19 27).

20  
21 *Stein*

22 Stein discloses a funds transfer transaction where at approximately the  
23 same time that the seller 28 sends information product to the buyer 20 via  
24 the Internet, the seller 28 also sends a transfer-request message 129 to the  
25 payment system 10 via the Internet 12. Specifically, the seller 28 sends the  
26 transfer-request message 129 to the front end program 90 on the front end

1 computer 50. The transfer-request message 129 may be sent by either e-mail  
2 or using an interactive protocol on the Internet 12. The transfer-request  
3 message 129 contains the following information: the buyer cardnumber  
4 102B, the seller cardnumber 102S, a transfer type 130 (e.g., sale of  
5 information), a textual description 132 of the transaction, a transfer amount  
6 134, the currency 112S (e.g., USD); and optionally, the merchant's  
7 transaction-identifier 136 (col. 7, ll. 34-48).

8 After receiving the transfer-request message 129, the front end  
9 program 90 asks the buyer 20 whether the buyer 20 wishes to authorize  
10 payment for the transaction 132 to the seller 28. Specifically, the front end  
11 program 90 sends a transfer-query message 140 to the buyer 20. Using the  
12 information contained in the transfer-request message 129 from the seller 28,  
13 specifically the buyer's cardnumber 102B and the seller's cardnumber 102S,  
14 the front end program 90 looks up the buyer's name 103B and the seller's  
15 name 103S. The transfer-query message 140 contains: a transaction-  
16 identifier 142 uniquely-generated by the front end program 90, the buyer's  
17 name 103B, the seller's name 103S, the transfer type 130, the textual  
18 description of the transaction 132, and a transfer amount 135 in the currency  
19 preference 112B associated with the buyer's cardholder account (which may  
20 represent a currency exchange of the transaction amount 134 into the buyer's  
21 currency preference 112B and further which fixes the transfer amount, with  
22 respect to currency fluctuations, in the currency used by the buyer). In  
23 addition, if currency denomination exchange occurred, the original currency  
24 112S and amount 134 are noted in the message 140. In the transfer-query  
25 message 140, the buyer's name 103B and the seller's name 103B are used  
26 instead of the buyer's cardnumber 102 and the seller's cardnumber 102S in

1 order to minimize transmission of the cardnumber information over the  
2 Internet thereby improving security of the system. After sending the  
3 transfer-query message 140, the front end program 90 waits for a response  
4 from the buyer 20 (col. 7, l. 49 through col. 8, l. 10).

5 The buyer 20 may respond by sending a transfer-response message  
6 150 to the front end computer 50 via the Internet. The transfer-response  
7 message 150 contains the following data: the payment system generated  
8 transaction-identifier 142 and an indication 152 of the buyer's willingness to  
9 allow transfer of funds. The willingness indication 152 is one of “yes,”  
10 “no,” or “fraud” (col. 8, ll. 11-18).

11  
12 *Daniels*

13 Daniels discloses that pop-up windows are windows which open or  
14 “pop-up” when a display button is actuated (col. 13, ll. 58-60).

15  
16 *Matyas*

17 Matyas discloses that Netscape Navigator (browser) can open a pop-  
18 up window, which will allow the user to download and install the required  
19 plug-in. Once the plug-in has been installed, it can be reused repeatedly  
20 without downloading each time (col. 12, ll. 41-45).

21 Using the information contained in the <EMBED> tag, the MiniPay  
22 plug-in displays a pop-up window with all the necessary information to  
23 permit the user to initiate a MiniPay payment order (col. 12, ll. 46-49).

PRINCIPLES OF LAW

*Obviousness*

One cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 402-03 (2007).

It is well-established that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. *See Chore-Time Equip., Inc. v. Cumberland Corp.*, 713 F.2d 774, 779 (Fed. Cir. 1983). *See also Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

During examination, the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

*Pop-Up Window*

We are not persuaded that the Examiner erred in asserting that a combination of Wilf, Stein, Paltenghe, Daniels, Matyas, and AAPA renders obvious the recitation of from the funds transfer server, interacting with the



1 pop-up window to present a transaction amount in the pop-up window, and  
2 receiving customer assent to the transaction amount, as recited in  
3 independent claims 1, 10, and 17 (App. Br. 5-6; Reply Br. 1-2). Stein  
4 discloses that transfer-query message 140 is sent from front-end program 90  
5 to buyer 20 (col. 7, ll. 52-54). Transfer-query message 140 includes transfer  
6 amount 134, 135, depending on the currency, and a request to buyer 20 to  
7 authorize the transfer via indication 152 in transfer-response message 150  
8 (col. 7, l. 58 through col. 8, l. 18). Accordingly, the Examiner has shown  
9 that front-end program 90 corresponds to the recited funds transfer server,  
10 that transfer-query message 140 corresponds to the recited interacting with  
11 the user's computer to present a transaction amount, and that indication 152  
12 via transfer-response message 150 corresponds to the recited customer  
13 assent. Thus, the only aspect missing from Stein is that the *form* of the  
14 interaction is with a pop-up window; the *interaction itself* is met by Stein.  
15 *See In re Keller*, 642 F.2d at 426.

16 Stein further discloses that transfer-request message 129, and thus also  
17 transfer-query message 140, may be sent by either e-mail or using an  
18 interactive protocol on the Internet 12 (col. 7, ll. 40-41). Daniels and Matyas  
19 each disclose that pop-up windows can be used for presenting information to  
20 the user. Matyas in particular discloses that pop-up windows can be used for  
21 financial transactions (col. 12, ll. 41-49). Accordingly, as Stein discloses  
22 that any interactive protocol can be used for presenting information to the  
23 user, and Daniels and Matyas disclose that pop-up windows are one such  
24 protocol, we agree with the Examiner that it would have been obvious to  
25 modify Stein to include the pop-up windows of Daniels and Matyas to arrive  
26 at the aforementioned aspects of independent claims 1, 10, and 17,

1 especially where Matyas discloses that pop-up windows can be used for  
2 financial transactions, and the number of ways for presenting information to  
3 the user are finite. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. at 402-03.

4  
5 *Level of Skill*

6 We are not persuaded that the Examiner erred in combining Wilf,  
7 Stein, Paltenghe, Daniels, Matyas, and AAPA, because the Examiner failed  
8 to explicitly identify the level of skill in the relevant art (App. Br. 7; Reply  
9 Br. 2). The prior art itself, which is all in the field of computers and the  
10 Internet, properly establishes the appropriate level of skill in the art. *See*  
11 *Chore-Time Equip., Inc. v. Cumberland Corp.*, 713 F.2d at 779.

12  
13 *Motivation*

14 We are not persuaded that the Examiner erred in combining Wilf,  
15 Stein, Paltenghe, Daniels, Matyas, and AAPA, because the Examiner only  
16 set forth one motivation from Wilf for combining all of the references (App.  
17 Br. 7; Reply Br. 2). For the pop-up window aspect, page 4 of the  
18 Examiner's Answer recites that "[t]he ordinary practitioner of the art would  
19 have seen it as obvious at the time of Applicant's invention that a web  
20 browser window was a practical and popular interface for displaying this  
21 transaction data for the customer buyer's authorization or rejection of the  
22 payment by transfer." The Examiner then cites Daniels, Matyas, and the  
23 AAPA as examples supporting this modification. Accordingly, the  
24 motivation for modifying Stein to include a pop-up window does not flow  
25 from Wilf.

*Dependent Claim 12*

We are not persuaded that the Examiner erred in asserting that a combination of Wilf, Daniels, Matyas, and AAPA renders obvious “wherein the pop-up window overlays an existing web browser window of a web site associated with the merchant system,” as recited in dependent claim 12 (App. Br. 7-8; Reply Br. 3). There are only two options for presenting a pop-up window in relation to another window: either it does or does not overlay an existing web browser window. Such limited options support a conclusion of obviousness. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. at 402-03.

*Dependent Claim 13*

We are persuaded that the Examiner erred in asserting that a combination of Wilf, Daniels, Matyas, and AAPA renders obvious “wherein the receiving transaction information step triggers the opening a pop-up window step,” as recited in dependent claim 13 (App. Br. 8; Reply Br. 3). The Examiner asserts that “Wilf, Daniels, Matyas and AAPA disclose a method wherein the receiving transaction information step triggers the opening of a pop-up window step (This triggering step is implicit to the way a pop-up window or automatically opening window is implicitly designed to work)” (Exam’r’s Ans. 7). Even if the cited references generally disclose the nature of how pop-up windows are triggered, the Examiner has not met the initial burden of showing how the references disclose that receiving transaction information triggers the opening as recited in dependent claim 13. *In re Oetiker*, 977 F.2d at 1445.

CONCLUSION

The Appellants have not shown that the Examiner erred in rejecting claims 1-12 and 14-20.

The Appellants have shown that the Examiner erred in rejecting claim 13.

DECISION

The decision of the Examiner to reject claims 1-12 and 14-20 is affirmed.

The decision of the Examiner to reject claim 13 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

hh

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834